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| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 10/590,481  | 08/24/2006  | Takashi Yamamoto     | 1011350-000379      | 8950             |
| 21839 7590 07/09/2008<br>BUCHANAN, INGERSOLL & ROONEY PC<br>POST OFFICE BOX 1404<br>ALEXANDRIA, VA 22313-1404 |             |                      |                     |                  |
| EXAMINER  |             |                      |                     |                  |
| MULCAHY, PETER D  |             |                      |                     |                  |
| ART UNIT  |             | PAPER NUMBER         |                     |                  |
| 1796  |             |                      |                     |                  |
| NOTIFICATION DATE   |             | DELIVERY MODE        |                     |                  |
| 07/09/2008  |             | ELECTRONIC           |                     |                  |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

ADIPFDD@bipc.com

# Office Action Summary

**Application No.**

10/590,481

**Applicant(s)**

YAMAMOTO ET AL.

**Examiner**

/Peter D. Mulcahy/

**Art Unit**

1796

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 09 April 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1, 4-6 and 12-25 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 4-6 and 12-25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/5508)  
Paper No(s)/Mail Date 4/9/08
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1, 4-6 and 12-25 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over either JP-A-2002-53358 or Dreher et al US 6,489,381.
4. The rejection over Sandoz EP 725 043 is withdrawn in view of the amendments, remarks filed in support thereof and the newly cited art.
5. The JP-A-2002-53358 document claims cement admixtures that are seen to incorporate polymers that anticipate the claimed "dry shrinkage-reducing agent" as claimed. It should be noted that the preamble "dry shrinkage-reducing agent" is seen as a mental step or intended utility and does not further limit the claim. The polymers claimed can have the same utility. Specifically, the monomer of formula 1 as instantly claimed is anticipated by the monomer of formula 2 as claimed in the JP claims. The

R4 as instantly claimed is anticipated by the R8 as claimed in the JP. The monomers claimed as formula 1 in JP anticipate those claimed as chemical 2 and/or 3 herein. Acid monomers that anticipate chemical 4 are claimed as well.

6. The art is silent as to the surface tension limitation claimed herein. Rejections under 35 USC 102/103 are proper when all compositional limitations are met and the art is silent as to a claimed property. It is reasonable to presume that the art has properties that either anticipate or render obvious those claimed given that the polymers are the same.

7. The Dreher et al patent exemplifies cement admixtures that are seen to incorporate polymers that anticipate the claimed "dry shrinkage-reducing agent" as claimed. It should be noted that the preamble "dry shrinkage-reducing agent" is seen as a mental step or intended utility and does not further limit the claim. The polymers claimed can have the same utility. Specifically, the monomer of formula 1 as instantly claimed is anticipated by the monomer (a) and the 2-ethylhexyl acrylate shown in the examples, see column 8 lines 15. The monomers shown as (c) anticipate those claimed as chemical 2 and/or 3 herein. Acid monomers that anticipate chemical 4 are exemplified as well.

8. The art is silent as to the surface tension limitation claimed herein. Rejections under 35 USC 102/103 are proper when all compositional limitations are met and the art is silent as to a claimed property. It is reasonable to presume that the art has properties that either anticipate or render obvious those claimed given that the polymers are the same.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to /Peter D. Mulcahy/ whose telephone number is 571-272-1107. The examiner can normally be reached on Mon.-Fri. 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on 571-272-1114. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Peter D. Mulcahy/  
Primary Examiner  
Art Unit 1796